

**IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE**

**Inventors:** David Gray Boyer et al.

**Serial No.:** 10/672633

**Conf. No.:** 8084

**Filing Date:** 09/26/2003

**Art Unit:** 2617

**Examiner:** Mehrpour, Naghmeh (Melody)

**Docket No.:** 633-061US

**Title:** Method and apparatus for delivering a voice mail message with an indication of the presence of the sender

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**PRE-APPEAL-BRIEF REQUEST FOR REVIEW**

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

Respectfully,  
David Gray Boyer et al.

By /Henry Vuu/  
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Dear Sir:

**PRE-APPEAL-BRIEF REMARKS**

This paper is responsive to the *Office Action* that issued in this case on 30 April 2010 and is further accompanied by a *Notice of Appeal/Pre-Appeal Conference Request*. In that *Office Action*, the Examiner rejected claims 1-24 as follows:

- Claims 1-8, 11-13, and 16-24 was rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 7,447,495 B2 (hereinafter "*Agrawal*").
- Claims 9, 10, 14, and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of *Agrawal* and U.S. Patent No. 6,718,014 (hereinafter "*Haim*").

The Applicants submit that the cited prior art omits essential limitations needed for a *prima facie* rejection. Because of these omissions, the Applicants respectfully request a panel review of the present application.

**35 U.S.C. § 102 Rejection of Claims 1-8, 11-13, and 16-24**

The Examiner alleged that *Agrawal* anticipates claims 1-8, 11-13, and 16-24. Applicants disagree for at least the reasons discussed below.

**A. Independent Claim 1:** In particular and as further discussed below, *Agrawal* fails to teach or suggest at least two limitations recited in claim 1. Claim 1 recites a method for delivering a voice mail message to a recipient comprising, in pertinent part:

receiving said voice mail message from a sender;  
obtaining a presence status [. . .]; and  
delivering said voice mail message to said recipient with an indication  
of a presence of said sender [. . .].

I. Agrawal does not provide any teaching, suggestion, or motivation regarding the limitation of “receiving a voice mail message from a sender [. . .] and delivering the voicemail message to a recipient [. . .],” as required by claim 1. The Applicant’s specification explicitly discloses that a “voice mail message” comprises audio message content. (See, specification at P4, L4-5.)

In the *Office Action*, the Examiner cited C6, L57 through C7, L2 of Agrawal to teach or suggest this limitation. The Examiner alleged that the “instant messaging” disclosed in this excerpt anticipates the “voice mail message” recited in claim 1. (See, *Final Action* at P3.)

The Examiner’s allegations are unreasonable because an “instant message” and a “voice mail message” are two distinct modes of communications. Some distinctions between “instant messaging” and a “voice mail message” include:

- **Instant Message:**

- (1) a sender of an instant message and a recipient of the instant message must be connected to a server at the same time to communicate with one another, and
- (2) an instant messages uses text as a mode of communication between two or more users.

- **Voice Mail Message:**

- (1) a sender of a voice mail message and a recipient of the voice mail message are not required to be connected to a server at the same time to transmit and receive a voice mail message, and
- (2) a voice mail message uses audio as a mode of communication between two or more users.

These distinctions are well known and well understood by those skilled in the art. As a consequence, one skilled in the art would not interpret the “instant message” disclosed in Agrawal as teaching or otherwise suggesting anything pertaining to the “voice mail message” recited in claim 1.

Moreover, the excerpt cited by the Examiner at best discloses presenting a “buddy list” to an instant messaging user. Based on the “buddy list,” the user can identify members of the

"buddy list" that are currently available. But nowhere does Agrawal teach or suggest anything pertaining to a "voice mail message" and transmitting/delivering the "voice mail message" to a recipient, as required by claim 1.

**II.** Agrawal does not provide any teaching, suggestion, or motivation regarding the limitation of "delivering a voice mail message to a recipient with an indication of a presence of the sender," as required by claim 1. This feature of the claimed invention is advantageous because it enables the recipient to better determine the "*best-way*" to respond to the "voice mail message." (See, specification at P2, L20-30.)

In the *Office Action*, the Examiner alleged that:

- the "instant message" disclosed in Agrawal anticipates the "voice mail message" recited in claim 1, and
- the "buddy list" disclosed in agrawal anticipates "delivering a voice mail message to a recipient with an indication of a presence of the sender" recited in claim 1.

The Examiner's allegations are unreasonable because Agrawal does not provide any teaching, suggestion, or motivation that the "instant message" is transmitted with the sender's "presence information" for display on the "buddy list," as alleged by the Examiner.

In fact, Agrawal teaches away from the limitation at issue at C5, L23-39 and C7, L29-31. The excerpts disclose transmitting an "instant message" from a client (602) to an "application server (604)." The "application server (604)" receives the "instant message" and determines whether to deliver, store, return, or discard the "instant message" based on "presence information" obtained from a "presence server (108)."

The excerpts teach away from the limitation at issue because the "presence server (108)" determines the "*best-way*" to respond to the "instant message" (in contrast to a recipient). In this regard, a recipient does not need to receive an instant message with the sender's "presence information" since the "presence server (108)" determines the "*best-way*" to deliver the "instant message."

**Example.** A recipient responds to a sender's "instant message" by transmitting another "instant message." An "application server (604)" receives the recipient's "instant message" and determines whether to deliver, store, return, or discard the "instant message," wherein the determination is based on the sender's "presence information" obtained from a "presence server (108)." (See, Agrawal at C5, L23-39 and C7, L29-31.)

In contrast to Agrawal, claim 1 requires transmitting a "voice mail message" with the "presence information" of a sender. As discussed above, this feature of the claimed invention is advantageous because it enables a recipient to better determine the "best-way" to respond to the "voice mail message." Agrawal, however, fails to provide any teaching, suggestion, or motivation regarding this feature of the claimed invention.

For at least the reasons discussed above, independent claim 1 is not anticipated by Agrawal. As a consequence, the applicants respectfully request that the panel reverse the Examiner's rejection of claim 1. Since claims 2-8 and 11 are dependent on claim 1, and claim 1 is believed to be allowable over Agrawal for the reasons presented, the Applicants respectfully request the panel reverse the rejection of these dependent claims as well.

**B. Independent Claim 12:** In particular and as further discussed below, Agrawal fails to teach or suggest at least two limitations recited in claim 12. Claim 12 recites a method for delivering a voice mail message to a recipient comprising, in pertinent part:

receiving said voice mail message from a sender;  
obtaining a presence status [. . .]; and  
providing a mechanism for said recipient to automatically respond to said sender at a device where said sender is believed to be present.

**I.** Agrawal does not provide any teaching, suggestion, or motivation regarding the limitation of "receiving a voice mail message from a sender [. . .] and delivering the voicemail message to a recipient [. . .]," as required by claim 12. This limitation is traversed for the same reasons as presented for independent claim 1, above.

**II.** Agrawal does not provide any teaching, suggestion, or motivation regarding the limitation of "providing a mechanism for a recipient to automatically respond to a sender at a device where the sender is believed to be present."

The Examiner states that claim 12 is rejected for the same reasons as claims 1 and 17. But these claims do not recite the limitation of "providing a mechanism for a recipient to automatically respond to a sender at a device where the sender is believed to be present."

For at least the reasons discussed above, independent claim 12 is not anticipated by Agrawal. As a consequence, the Applicants respectfully request that the panel reverse the Examiner's rejection of claim 12. Since claims 13 and 16 are dependent on claim 12, and claim 12 is believed to be allowable over Agrawal for the reasons presented, the Applicants respectfully request the panel reverse the rejection of these dependent claims as well.

**C. Independent Claim 17:** In particular and as further discussed below, Agrawal fails to teach or suggest at least two limitations recited in claim 17. Claim 17 recites an apparatus for delivering a voice mail message to a recipient comprising, in pertinent part:

a memory; and  
at least one processor, coupled to the memory, operative to:  
receive said voice mail message from a sender;  
obtain a presence status [. . .]; and  
delivering said voice mail message to said recipient with an indication  
of a presence of said sender [. . .].

Claim 17 is allowable over Agrawal for essentially the same reasons as independent claim 1. Namely, Agrawal fails to provide any teaching, suggestion, or motivation that an apparatus comprises a processor, coupled to a memory, operative to:

- “receive a voice mail message from a sender [. . .] and delivering the voicemail message to a recipient [. . .],” and
- “deliver the voice mail message to the recipient with an indication of a presence of the sender.”

As a consequence, the Applicants respectfully request that the panel reverse the Examiner’s rejection of independent claim 17. Since claims 18-24 are dependent on claim 17, and claim 17 is believed to be allowable over Agrawal for the reasons presented, the Applicants respectfully request the panel reverse the rejection of these dependent claims as well.

### **35 U.S.C. 103 Rejection of Claims 9, 10, 14, and 15**

The Office alleged that combination of Agrawal and Haim obviates claims 9, 10, 14, and 15.

Haim provides no teaching or suggestion regarding:

- “receiving a voice mail message from a sender [. . .] and delivering the voicemail message to a recipient [. . .],” as recited in claims 1 and 12;
- “delivering the voice mail message to the recipient with an indication of the sender’s presence,” as recited in claims 1 and 17; or
- “providing a mechanism for said recipient to automatically respond to said sender at a device where said sender is believed to be present,” as recited in claim 17.

As a consequence, Haim does not cure the deficiencies of Agrawal with respect to these limitations of independent claims 1, 12, and 17. Since claims 9, 10, 14, and 15 are dependent on claims 1, 12, and 17, the Applicants respectfully request the panel reverse the rejection of these dependent claims as well.